

REMARKS

Applicant respectfully requests reconsideration of the claims pending in this U.S. Patent application. Claims 1-5, 7, 10, 12-17, 20-22, 24, and 25 have been amended. No claims have been added or cancelled in this response. Thus, claims 1-5 and 7-28 are pending.

Claim Rejections - 35 U.S.C. § 102

Claims 1-3, 12-13, 16-19, and 21 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 4,937,863 issued to Robert, et al. (*Robert*). For at least the reasons set forth below, Applicant submits that claims 1-3, 12-13, 16-19, and 21 are not anticipated by *Robert*.

The Manual of Patent Examining Procedure ("MPEP"), in § 2131, states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 869 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Thus, under 35 U.S.C. § 102, a claim is anticipated *only if* each and every element of the claim is found in the cited reference and the cited reference must show the invention in as complete detail as contained in the claim.

Independent claim 1, as amended, recites the following:

an electronic asset lending library database containing a **plurality of user accounts** and at least one license for an **electronic asset assigned by a user having one of a plurality of user accounts**;
 an account manager to maintain the user accounts;
 an asset manager to maintain the license for the electronic asset; and
 a loan manager to **control the assignment of the license for the electronic asset to another user having another one of the plurality of user accounts**.

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(emphasis added). Independent claims 12, 16, and 22 similarly recite "a plurality of user accounts" and "controll[ing] the assignment of [a] license ... to another user having another one of the plurality of user accounts."

The Office action cites *Robert* as teaching the above-stated claim limitations in figure 1, item 10. Regarding figure 1, item 10 *Robert* states:

In particular, the license management facility 10 then determines whether the usage of the licensed program is permitted under usage limitations. In that operation, the license management facility obtains the number of license units remaining, which indicates usage of the licensed program 14 not including the usage requested by the user ... The license management facility 10 then compares the number of license units which would be allocated for use of the licensed program 14 ... and the number of remaining license units to determine whether sufficient license units remain to permit usage of the licensed program 14. (Column 4, lines 11-16, emphasis added).

Thus, *Robert* discloses a software licensing management system directed to regulating the use of software in accordance with the terms of an associated license. See column 1, lines 64-68. Specifically, *Robert* addresses the need to regulate the relationship between the cost of a license and the use of associated software. See column 1, lines 45-57. In order to manage the cost versus use relationship, *Robert* discloses that a license is granted based on whether "a license usage allocation value" exceeds "a license unit value." See column 2, lines 15-25. A "license unit value" is a measure of the total value of a license associated with a software program. In contrast, "a license usage allocation value" is a measure of the amount of cumulative use of the software. Thus, as the "license usage allocation value" approaches the "license unit value," a software program may no longer be licensed. Importantly, the system disclosed in *Robert* is directed to maintaining a plurality of tables with "usage allocation values" and "license unit values" for a number of software programs.

Applicant respectfully submits, however, that *Robert* does not disclose "a plurality of user accounts," as recited in claims 1, 12, 16, and 22. As shown in FIG. 1 and FIG. 2, the

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license management facility merely accesses a license database (e.g., license database 11). FIG. 2 shows that the entries in the license database pertain to characteristics of a particular copy of a software program rather than characteristics of a user. Since *Robert* does not disclose "a plurality of user accounts," Applicant respectfully submits that *Robert* cannot disclose "control[ling] the assignment of [a] license ... by another user having another one of the plurality of user accounts," as recited in claims 1, 12, 16, and 22. Thus, Applicant respectfully submits that *Robert* does not anticipate claims 1, 12, 16, and 22 for at least the reason that *Robert* does not disclose "control[ling] the assignment of [a] license ... by another user having another one of the plurality of user accounts."

Claims 2 and 3 depend from claim 1. Claim 13 depends from claim 12. Claims 17-19 and 21 depend from claim 16. Because dependent claims include the limitations of the claims from which they depend, Applicant submits that claims 2, 3, 13, 17-19, and 21 are not anticipated by *Robert*, for at least the reasons stated above.

Claim 22 was rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,745,879 issued to Wyman (*Wyman*). For at least the reasons set forth below, Applicant submits that claim 22 is not anticipated by *Wyman*.

Claim 22 recites the following:

managing a plurality of user accounts;
generating a license and associated license restrictions for an electronic asset on a lending library server, the electronic asset assigned by a user having one of the plurality of user accounts;
displaying to an assignee having another one of the plurality of user accounts the license and associated license restrictions on a lending library client ...

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Regarding these claim elements directed to a plurality of user accounts, the Office action directs the Applicant's attention to column 6, lines 13-25, wherein *Wymann* states:

A license server administers the license, and each licensed product upon start-up makes a call to the license server to check on whether usage is permitted, in a manner similar to that of U.S. Pat. No. 4,937,863. ... The license server maintains a database of product use authorizations for the licensed products, and access this database for updating and when a request is received from a user.

Thus, *Wymann* discloses a system for managing licenses that is "similar to that of U.S. Pat. No. 4,937,863" (*Robert*). Like *Robert*, *Wymann* discloses a license server that maintains a license database (e.g., database of product use authorization) containing entries that pertain to licenses and corresponding software programs. *Wymann* does not, however, disclose "a plurality of user accounts," as recited in claim 22. As shown in FIG. 2, the entries in the product use authorization database pertain to characteristics of a particular copy of a software program rather than characteristics of a user. Since *Wymann* does not disclose "a plurality of user accounts," Applicant respectfully submits that *Wymann* cannot disclose "control[ling] the assignment of [a] license ... to another user having another one of the plurality of user accounts," as recited in claim 22. Thus, Applicant respectfully submits that *Wymann* does not anticipate claim 22 for at least the reason that *Wymann* does not disclose "control[ling] the assignment of [a] license ... to another user having another one of the plurality of user accounts."

Claims 23-26 depend from claim 22. Because dependent claims include the limitations of the claims from which they depend, Applicant submits that claim 23-26 are not anticipated by *Wymann*, for at least the reasons stated above.

Claim Rejections - 35 U.S.C. § 103

Dependent claims 4, 5, 7-11, 14, 15, 20, 27, and 28 were rejected under 35 U.S.C. §

103(a) as being unpatentable over *Robert* in view of *Wymann* and in further view of U.S. Patent

No. 6,892,900 issued to Ginter, et al. (*Ginter*). Claims 4, 5, 7-11, 27, and 28 depend from claim

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1. Claims 14 and 15 depend from claim 12. Claim 20 depends from claim 16. For at least the reasons set forth below, Applicants submit that dependent claims 4, 5, 7-11, 14, 15, 20, 27, and 28 are not rendered obvious by *Robert*, *Wyman*, and *Ginter*.

The Manual of Patent Examining Procedure ("MPEP"), in § 706.02(j), states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art and not based on applicant's disclosure. *In re Voegt*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Thus, the MPEP and applicable case law require that the Office action

establish that a combination of references teach or suggest all of the claim limitations of

rejected claims to sustain an obviousness rejection under 35 U.S.C. § 103. As shown below,

Applicant respectfully submits that the Office action does not establish a *prima facie* case of obviousness.

As discussed above, claims 1, 12, 16, and 22 recite "a plurality of user accounts" and "control[ing] the assignment of [a] license ... to another user having another one of the plurality of user accounts." Also, as shown above, neither *Robert* nor *Wyman* teach or suggest "a plurality of user accounts" and "control[ing] the assignment of [a] license ... to another user having another one of the plurality of user accounts," as claimed by Applicant.

Ginter is cited as teaching "an Access Control List (ACL) ... for the purpose of providing full control over pre-defined and user-defined application events." Whether or not *Ginter* discloses an ACL, it does not teach or suggest "a plurality of user accounts" and "control[ing] the assignment of [a] license ... to another user having another one of the plurality of user accounts," as claimed by Applicant. *Ginter*, therefore, does not cure the deficiencies of *Robert*

and *Wyman*. Thus, Applicant respectfully submits that no combination of *Robert*, *Wyman*, and *Ginter* renders claims 4, 5, 7-11, 14, 15, 20, 27, and 28 obvious.

Conclusion

For at least the foregoing reasons, Applicant submits that the rejections have been overcome. Therefore, claims 1-5 and 7-28 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: 20 JUL 2003

P. A. Pedigo

Philip A. Pedigo
Reg. No. 52,137

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025-1026
(503) 684-6200

Received from < 503 684 3245 > at 6/20/03 9:59:19 PM [Eastern Daylight Time]

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